


PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 2222.0320000	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____		Application Number 09/934,121	Filed August 21, 2001
		First Named Inventor William J. BYRNE	
		Art Unit 2614	Examiner ELAHEE, MD S
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input type="checkbox"/> attorney or agent of record. Registration number _____ <input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 60,889		 _____ Signature Salvador M. Bezos _____ Typed or printed name (202) 371-2600 _____ Telephone number 13 OCT 2010 _____ Date	
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<div style="border: 1px solid black; padding: 5px;"><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</div>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BYRNE *et al.*

Appl. No.: 09/934,121

Filed: August 21, 2001

For: **Dynamic Interactive Voice Interface**

Confirmation No.: 7730

Art Unit: 2614

Examiner: ELAHEE, MD S

Atty. Docket: 2222.0320000

Arguments to Accompany the Pre-Appeal Brief Request for Review

Mail Stop AF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby submit the following Arguments, in five (5) or less total pages, as attachment to the Pre-Appeal Brief Request for Review (Form PTO/SB/33). A Notice of Appeal is concurrently filed.

Arguments

The Examiner has maintained the rejection of claims 10, 56, 65, 74, and 89 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent Application Publication No. 2005/0091056 to Surace et al. ("Surace") in view of U.S. Patent Application Publication No. 2003/0005062 to Hachiya et al. ("Hachiya"). Applicants respectfully traverse.

1. The Examiner has failed to identify a single element of the combination of Surace and Hachiya corresponding to the "user" of the instant claims

Claim 10 recites, *inter alia*, "presenting an input interface to enable the user to specify personality information comprising one or more individual character traits without regard to user interaction history" and "storing, at a computing device, the individual character traits in a user profile having preference information for the user." The combination of Surace and Hachiya fails to teach or suggest at least these features of claim 10.

In making his rejection of claim 10 with respect to the foregoing features, the Examiner relies exclusively on Surace as allegedly supplying the requisite teaching or suggestion. As has been articulated by Applicants in prior replies, it is clear from the foregoing features that “the user,” through proper application of antecedent basis, is the same user that “specif[ies] personality information” and that has “a user profile having preference information for the user,” as recited in claim 10.

The Examiner argues in the Response to Arguments section of the Final Office Action dated July 8, 2010 (“Final Office Action”) that “[t]he claimed user is so broad that it can cover subscriber/developer/actor of Surace.” (Final Office Action, p. 2). This looks at the term “user” in isolation (i.e., for any single instance of “user” in a claim). However, this is not a proper interpretation of claim 10 as written, where the same “user” is involved in each of the recited features.

The Examiner clarifies the argument in the Advisory Action dated September 28, 2010 (“Advisory Action”) by proposing that all of the foregoing steps are performed by a single entity in Surace, specifically the subscriber, which the Examiner treats as the claimed user. (Advisory Action, p. 2, “the subscriber of Surace is interpreted as the claimed user”). In particular, the Examiner states that “after the prompt is recorded, the consumer calls into the system and the recorded prompt is generated (with the required personality) and played back to the consumer” and that therefore “the subscriber/developer [i.e., user] not the actor stores the selected personality type on a profile and then virtual host is generated using the selected personality type (see page 12, paragraphs 0145-0147, 0149).” (Advisory Action, p. 2).

Nevertheless, Surace does not teach or suggest “storing, at a computing device, the individual character traits in a user profile having preference information for the user,” as recited in claim 10, where the “user” is the subscriber of Surace. Instead, the Examiner relies on

introducing ambiguity between two separate entities, the *subscriber* and the *developer* of Surace, to attempt to identify the single “user” recited in claim 10.

The *developer* of Surace creates the individual personalities by selecting the personality type (as acknowledged by the Examiner at Final Office Action, pp. 3 and 5, and Advisory Action, p. 2, “at step 304, the *developer* selects the personality type”). This is the only possible point in Surace where “*individual character traits*” may be specified (and it is the developer that does so), as these are then fixed for recording by an actor. (Surace at [0039]-[0044]). Nowhere in Surace does the *developer* have any sort of “user profile having preference information for the user.” (i.e., there is no such thing as a “developer profile having preference information for the developer” in Surace -- the developer has no need to store the developer’s preferences).

In contrast, the *subscriber* of Surace does not specify “*individual character traits*,” as these have already been fixed and incorporated into various personalities in Surace, and can only ever specify an entire personality to use rather than individual character traits. (Surace at [0039]-[0044]). Even if the subscriber of Surace has a “user profile having preference information for the user,” it is not used to store “*individual character traits*.”

In order for the Examiner’s construct to work, the *subscriber* and the *developer* of Surace must be the same entity, which is not contemplated by the cited reference. As claimed here, the “user” of claim 10 cannot be *both*, simultaneously, the *subscriber* and the *developer* of Surace. Moreover, because the combination of Surace and Hachiya fails to contemplate a scenario where the subscriber is *the same* “user” as the developer of Surace, the Examiner must employ impermissible hindsight in order to argue the obviousness of this conclusion.

2. *The Examiner’s analogy fails to account for the user profile having preference information for the user*

Moreover, by contemplating a user that is an amalgamation of the subscriber and developer of Surace, an additional incongruent result is evident in the recited “preference

information.” In the claim feature “storing, at a computing device, the individual character traits in a user profile having preference information for the user,” the “preference information” would apply to a developer/subscriber, as applied by the Examiner. Even assuming, *arguendo*, that the “developer” of Surace can serve as the “user” of the claims, storing preference information for a developer leads to an incongruent result.

In particular, dependent claim 17 recites, *inter alia*, “wherein the ***user profile*** further includes ***user interaction history information***, the method further comprising: adjusting the conversational style based on the user interaction history information.” It would not be possible for Surace to teach, suggest, or disclose “user interaction history information” where the user is the “developer” of Surace, for storage in a “user profile.” Such a configuration of Surace would not be readily understood by one of ordinary skill in the art, and therefore is an impermissibly broad interpretation of independent claim 10 in its recitation of a “user profile”. Nor does the Examiner attempt to resolve this ambiguity regarding a “user profile” for a “developer” of Surace.

3. *Hachiya does not supply the missing teaching or suggestion*

Hachiya does not teach or suggest, nor does the Examiner rely on Hachiya to allegedly teach or suggest, any of the aforementioned features discussed with regard to Surace. Neither does the combination of Surace and Hachiya teach or suggest any of the above missing features. Instead, the Examiner relies on Hachiya to allegedly teach “behavior of the virtual host modified by user interaction history.” (Final Office Action, p. 6). Hachiya is directed to adjusting parameters of an agent “by the interaction with the post pet 103A performing the operation as determined by the agent parameters annexed to the E-mail.” (Hachiya at [0164]). This functionality of Hachiya does not supply the missing teaching or suggestion for the myriad features identified above that are not present in Surace.

4. **Conclusion**

For at least the foregoing reasons, claims 10, 56, 65, 74, and 89 are not rendered obvious by the combination of Surace and Hachiya. Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection of 10, 56, 65, 74, and 89 under 35 U.S.C. § 103(a).

The Examiner has further maintained the rejection of claims 11-18, 57-64, 66-73, and 75-88 under 35 U.S.C. § 103(a) as allegedly being obvious over Surace in view of Hachiya, and further in view of U.S. Patent No. 6,301,339 to Staples et al., U.S. Patent No. 5,189,702 to Sakurai et al., U.S. Patent No. 5,768,508 to Eikeland, U.S. Patent No. 5,911,043 to Duffy et al., U.S. Patent No. 6,366,882 to Bijl et al., U.S. Patent No. 4,531,184 to Wigan et al., and U.S. Patent No. 4,964,077 to Eisen et al. These claims are allowable over the combination of Surace and Hachiya for at least the reasons presented above, and the foregoing additional references do not supply the missing teachings or suggestions. Accordingly, reconsideration and withdrawal of the rejections is respectfully requested.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

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